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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,759	02/04/2004	Phillip L. Lam	PERFECT-1/CIP	5694
1054	7590	03/01/2006	EXAMINER	
LEONARD TACHNER, A PROFESSIONAL LAW CORPORATION 17961 SKY PARK CIRCLE, SUITE 38-E IRVINE, CA 92614			MICHALSKI, SEAN M	
			ART UNIT	PAPER NUMBER
			3725	

DATE MAILED: 03/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary	Application No. 10/772,759	Applicant(s) LAM, PHILLIP L.	
	Examiner Sean M. Michalski	Art Unit 3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 9 is objected to because of the following informalities: It is in improper dependent form. Claim 9 depends from claim 11, which is improper. For this examination, claim 10 becomes claim 9, claim 11 becomes claim 10, claim 9 becomes claim 11. Therefore claim 9 is independent; claim 11 depends from 10, which depends from 9. Appropriate correction is required.
2. Claim 9 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim (claim 11). Applicant is required to cancel the claim(s), or rewrite the claim(s) in independent form. Claim 9 is identical to and does not distinguish over claim 11.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claim 2 recites the limitation "'first and second ends are each adapted to attach to said elongated member". The first and second ends are previously defined as sections of the elongated member. Something cannot be adapted to attach to itself. This claim is unclear, and does not distinctly claim the subject matter which applicant regards as his invention. For examination purposes the claim will be interpreted as best understood by the examiner to read – the appliance as in claim 1 wherein said

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elongated member is adapted to receive a member in each of the first and second ends--.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Pesko (USPN 2,918,924)

Regarding Claim 1, Pesko discloses a manicuring appliance (figure 1) comprising an elongated member (10, figure 1) having first and second ends (left end 12 and right end 14, figure 1), said first end being adapted (12 figure 1) to receive a pushing member (20 figure 1) in a position to push a cuticle along an accurate path.

6. Regarding claim 2, Pesko further discloses the appliance as in claim 1 wherein said elongated member is adapted to receive a member in each of the first and second ends (figure 1 shows members being received in each of it's first and second ends—end 12 and end 14)

7. Regarding claim 3, Pesko discloses an appliance as in claim 1 wherein said pushing member is removable(20 is distinct and removable from elongate member 10).

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8. Regarding claim 4 Pesko discloses the appliance as in claim 1 wherein said pushing member comprises an arcuate edge (24 figure 1) and said edge is at the bottom of an arcuate surface (white area of 20 figure 1 is arcuate because of it's upper edge, 24 is at the bottom of the arcuate surface 20).

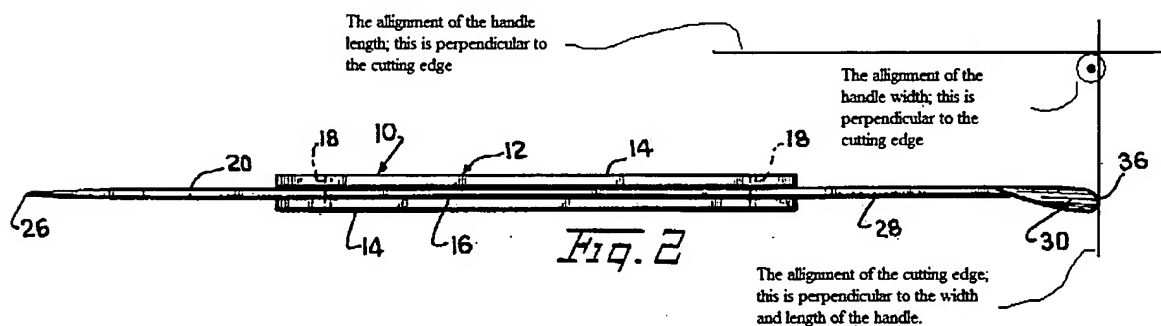
9. Regarding claim 5, Pesko discloses a cuticle appliance comprising a handle member(10 figure 1) and at least one end member(20 figure 1), said end member having at least one pusher(22 figure 1) for pushing a cuticle along an arcuate path (the pusher 22 is capable of pushing a cuticle along any user defined path, including an arcuate one) . The Functional recitation that one pusher be "for pushing a cuticle along an arcuate path" has not been given patentable weight because it is in narrative form. In order to be given patentable weight, a functional recitation must be expressed as a "means" for performing the specified function, as set forth in 35 USC § 112, 6th paragraph, and must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. *In re Fuller*, 1929 C.D. 172, 389 O.S. 279.

10. Regarding claim 6, Pesko further discloses that the appliance as described in claim 5 has a pusher (22 figure 1) configured for removal and replacement (20 is distinct and removable from elongate member 10 by removing 18; once removed, 20 could be replaced by a member substantially similar to 20).

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11. Regarding claim 7 Pesko further discloses that the appliance as described in claim 5 has a pusher (22 figure 1), which is detachable (20 is detachable from elongate member 10 by removing 18).

12. Regarding claim 8, Pesko further teaches that said elongated handle have a length exceeding its width (see figure 1) and having at least one end having a blade (36 figure 3), said blade having a cutting edge (38 figure 3) for removing cuticle skin (the blade is capable of removing cuticle skin, and was designed to cut said cuticle skin; column 3 lines 10-30). The Functional recitation that said blade be "for removing cuticle skin" has not been given patentable weight because it is in narrative form. In order to be given patentable weight, a functional recitation must be expressed as a "means" for performing the specified function, as set forth in 35 USC § 112, 6th paragraph, and must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. *In re Fuller*, 1929 C.D. 172, 389 O.S. 279. Pesko further discloses that the blade edge is substantially perpendicular to said length and width of said handle (see figure below, the dot represents the handle width going into the plane of the page)

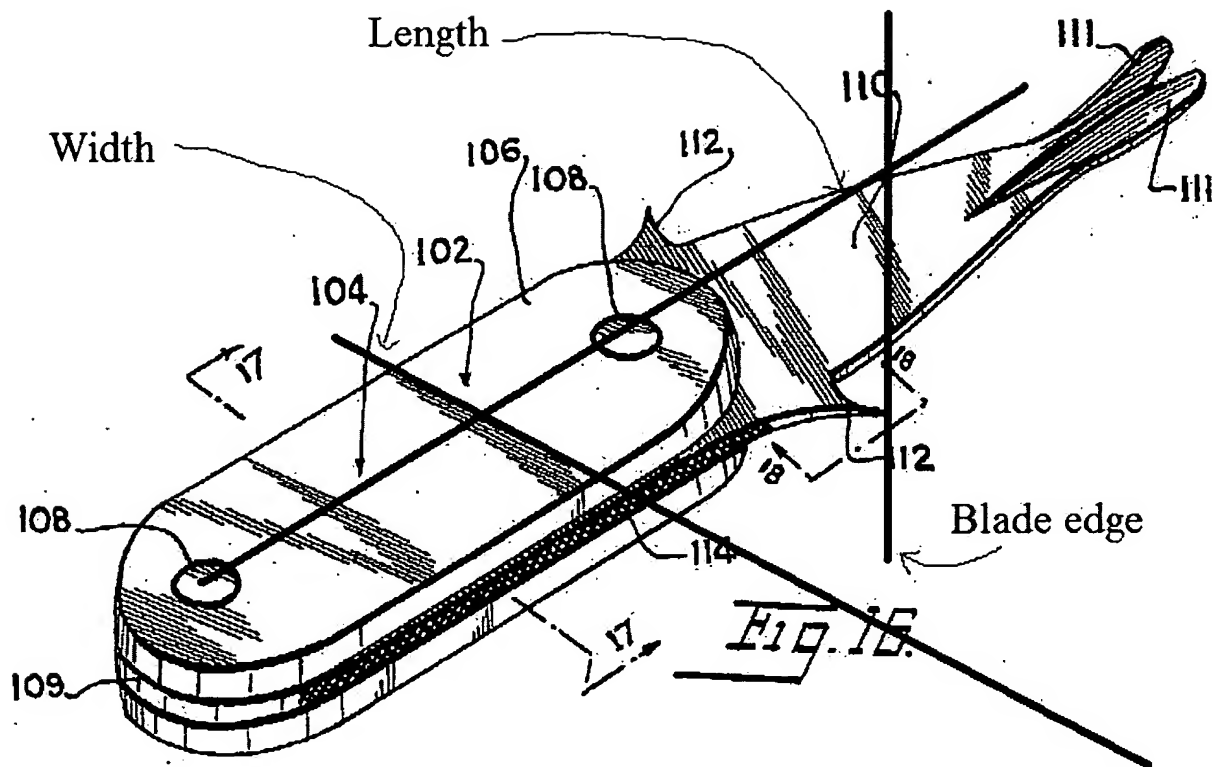


Pesko further discloses that a pusher be affixed to a second end of said handle (see figure 1) and having an arcuate edge for pushing cuticles (the edge 26, figure 1 is capable of pushing cuticles). The Functional recitation that said pusher be "for pushing cuticles" has not been given patentable weight because it is in narrative form. In order to be given patentable weight, a functional recitation must be expressed as a "means" for performing the specified function, as set forth in 35 USC § 112, 6th paragraph, and must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. *In re Fuller*, 1929 C.D. 172, 389 O.S. 279.

13. Regarding claim 9 (re-numbered from 10), Pesko discloses an elongated handle(10 figure 1) having a length exceeding it's width (as seen in figure 1) and having at least one end (106 figure 16) having a pair of spaced apart blade edges (the points of 112, figure 16), said blade edges being perpendicular to said handle width and length

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(as shown in the figure below)



Pesko further discloses a pusher being attached to the a second end of said handle (20 figure 1) and having an arcuate edge (26 figure 1) for pushing cuticles (26 is capable of pushing cuticles). The Functional recitation that said pusher be "for pushing cuticles" has not been given patentable weight because it is in narrative form. In order to be given patentable weight, a functional recitation must be expressed as a "means" for performing the specified function, as set forth in 35 USC § 112, 6th paragraph, and must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. *In re Fuller*, 1929 C.D. 172, 389 O.S. 279.

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14. Regarding claim 10 (renumbered from 11) Pesko discloses that said pusher be detachable (20 is distinct from 10 and is detachable by removing 18).

15. Claim 11 (renumbered from 9), is identical to and does not distinguish over claim 10. Pesko discloses that said pusher be detachable (20 is distinct from 10 and is detachable by removing 18).

16. Regarding claim 12, Pesco discloses an apparatus (10 figure 1) for use in a manicuring appliance for trimming dead skin from cuticles by cutting along an arcuate path with a blade edge; the apparatus comprising: a blade-holding device (41 figure 1) having a blade receiving member (32 figures 1 and 3) and being configured for releasable connection to a handle (14 and 18, figure 1, provide a releasable connection), at least one blade (36 figure 1) positioned in said blade receiving member (32 figure 3) and having an edge for cutting along said arcuate path (38 figure 3); and a pusher for preparing cuticles for cutting by said at least one blade (20 and 22, figure 1).

17. Claim 13 is rejected under 35 U.S.C. 102(b) as being anticipated by Papanikolaou (USPN 4,473,943).

Papanikolaou discloses an elongated handle (18 figure 2) having an end (34 figure 2) having a transparent end portion (12 figure 2), having at least one pusher (14 figure 2) and an illuminating device (36 figure 2) positioned for projecting light through said end portion (as seen in figure 2) for illuminating cuticle pushing. The Functional recitation that said pusher be "for pushing cuticle tissue" has not been given patentable weight because it is in narrative form. In order to be given patentable weight, a

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functional recitation must be expressed as a “means” for performing the specified function, as set forth in 35 USC § 112, 6th paragraph, and must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. *In re Fuller*, 1929 C.D. 172, 389 O.S. 279.

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

20. Claims 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Samiean (USPN 6,155,270) in view of Douglass (USPN 4,288,920).

Regarding claim 14, Samiean teaches a manicuring appliance having an elongated handle (the dolphins torso figure 1), with a detachable end portion (the tail

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fin, figures 2 and 3, shown to be detachable) having at least one pusher (the left point of the fin is capable of being a pusher for pushing cuticle tissue). Samiean does not teach a release lever for detaching said end portion from said handle.

Douglass et al. teaches the use of a lever (44 figure 10) for detaching an end portion (1 figure 2).

In the same problem solving area it would have been obvious to one skilled in the art at the time of the invention to modify Sameian by including a lever to release the head portion as taught by Douglass et al. The motivation to combine is to provide a different release mechanism configuration.

Regarding claim 15, Samiean further teaches that said pusher is made of plastic material (column 4, lines 33-37). Plastic is identical to "polycarbonate plastic" and does not distinguish over it. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious mechanical design expediency. *In re Leshin*, 125 USPQ 416.

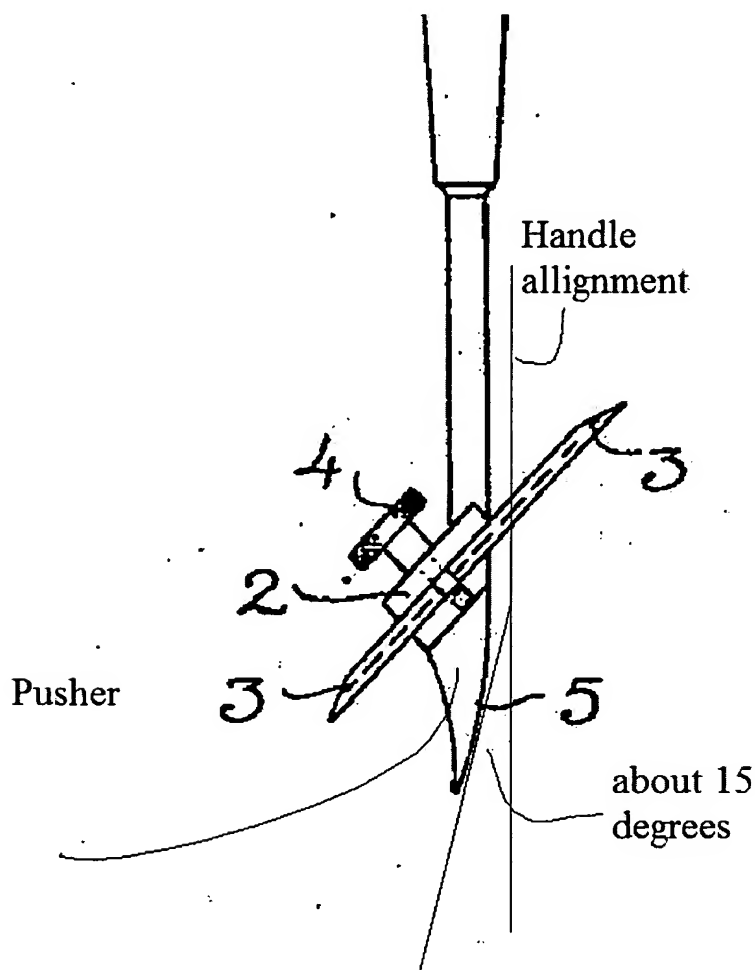
Regarding claim 16 Samiean further teaches that said pusher has an arcuate pushing edge (see figure 8, the center of the fin and each tip are all arcuate).

Regarding claim 17, samiean further teaches that the pushing edge is elevated (the tip of the fin in figure 8 is elevated with respect to the handle).

21. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Samiean (USPN 6,155,270) in view of Douglass et al.(USPN 4,288,920) in further view of Wendt (USPN 1,566,712).

Samiean in view of Douglass et al. teaches all the limitations of the claimed invention except that said pushing edge be elevated at an angle of about 15 degrees relative to said handle.

Wendt teaches a pushing edge which is elevated at an angle of 15 degrees relative to said handle (see picture below).



In the same field of invention it would have been obvious to one skilled in the art at the time of the invention to modify Samiean in view of Douglass et al. by angling the pusher at 15 degrees as taught by Wendt. The choice of an angle is well within the routine skill in the art. Samiean in view of Douglass et al. discloses the claimed

invention except for the limitation that the angle be 15 degrees. It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Conclusion

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Rogers (USPN 2,513,208) discloses a cuticle pusher.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean M. Michalski whose telephone number is 571-272-6752. The examiner can normally be reached on M-F 7:30AM - 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 571-272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

smm

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DERRIS H. BANKS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700